



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,232	03/23/2006	Philippe G. Nantermet	21546YP	5429
210 7590 08/19/2008				
MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER				
WARD, PAUL V				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
08/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/573,232

Applicant(s)

NANTERMET ET AL.

Examiner

PAUL V. WARD

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 and 23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

NOTE: The previous Office Action, dated May 14, 2008, has been withdrawn and vacated, and replaced by this Office Action. Applicant is expected to respond to each and every ground of rejection set forth herein below.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is phenyl and naphthyl. These are classifiable in classes various, subclasses various.
- II. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is piperazinyl. These are classifiable in classes 544 and 514, subclasses various.
- III. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is piperidiny, pyridyl, quinolinyl, dihydropyridinyl and isoquinolinyl. These are classifiable in classes 546 and 514, subclasses various.
- IV. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is pyrrolyl, dihydropyrrolyl, pyrrolidinyl and indolyl. These are classifiable in classes 544 and 514, subclasses various.
- V. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is pyrazinyl and dihydropyrazinyl. These are classifiable in classes 544 and 514, subclasses various.
- VI. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is pyrazolyl and dihydropyrazolyl. These are classifiable in classes 548 and 514, subclasses various.
- VII. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is pyridazinyl. These are classifiable in classes 544 and 514, subclasses various.
- VIII. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is pyrimidinyl and dihydropyrimidinyl. These

are classifiable in classes 544 and 514, subclasses various.

- IX. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is tetrazolyl and dihydrotetrazolyl. These are classifiable in classes 548 and 514, subclasses various.
- X. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is furanyl, dihydrofuranyl and tetrahydrofuranyl. These are classifiable in classes 549 and 514, subclasses various.
- XI. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is imidazolyl, dihydroimidazolyl and benzimidazolyl. These are classifiable in classes 548 and 514, subclasses various.
- XII. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is triazinyl. These are classifiable in classes 544 and 514, subclasses various.
- XIII. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is pyranlyl and tetrahydropyranlyl. These are classifiable in classes 549 and 514, subclasses various.
- XIV. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is thiazolyl. These are classifiable in classes 548 and 514, subclasses various.
- XV. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is triazolyl and dihydrotriazolyl. These are classifiable in classes 548 and 514, subclasses various.
- XVI. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is thienyl, dihydrothienyl, thiophenyl, and tetrahydrothienyl. These are classifiable in classes 549 and 514, subclasses various.
- XVII. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is morpholinyl and thiomorpholinyl. These are classifiable in classes 544 and 514, subclasses various.
- XVIII. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is dihydrothiadiazolyl. These are classifiable in classes 548 and 514, subclasses various.

- XIX. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is oxazolyl, isoxazolyl and benzoxazolyl. These are classifiable in classes 548 and 514, subclasses various.
- XX. The compounds, compositions and method according to claims 1-21 and 23, of formula I, wherein R¹ is oxadiazolyl. These are classifiable in classes 548 and 514, subclasses various.

It should be noted that in claim 9, thiazolyl is listed twice (in lines 6 and 8).

Appropriate correction is required.

The inventions listed as Groups I-XX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I is drawn to a compound, its composition and method of use. Group II is a different compound with respect to the compound of Group I. Therefore, there is no special technical feature for the compounds or different fields of application of the compounds. Additionally, there is no unity of invention.

There is no special technical feature, which unites the groups. But even if there were a special technical feature there must be unity of invention also. Under 37 CFR 1.475:

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or

corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

The above groups 1-2 together do not meet the requirement of unity of invention as given above in (1) -(5).

A telephone call was made to John Todaro on August 13, 2008 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant election should also include a specifically disclosed species to be examined for search purposes in the response. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

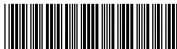
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/James O. Wilson/
Supervisory Patent Examiner,
Technology Center 1600**

Application Number**Application/Control No.**

10/573,232

Examiner

PAUL V. WARD

**Applicant(s)/Patent under
Reexamination**

NANTERMET ET AL.

Art Unit

1624